

Notice of Allowability

Application No.

10/052,362

Examiner

Zachary C. Tucker

Applicant(s)

LIM ET AL.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9 and 16 January 2004.
 2. ☒ The allowed claim(s) is/are 1-10.
 3. ☐ The drawings filed on _____ are accepted by the Examiner.
 4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S AMENDMENT

This application is in condition for allowance except for the presence of claims 11-24, which were non-elected without traverse in the correspondence from applicants dated 11 September 2003. Accordingly, claims 11-24 have been cancelled, pursuant to MPEP 821.02, which directs the examiner to do so.

IN THE CLAIMS –

Claims 11-24 have been cancelled.

Response to Amendment

The amendments to the specification at pages 2, 3 and 4 have been entered, as requested in the correspondence dated 16 January 2004.

The amendments to claims 1 and 7 have been entered, as requested in the correspondence from applicants dated 9 January 2004.

Status of Claim Rejections - 35 USC § 112

In the previous Office action, dated 9 October 2003, claims 1-10 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness. The definition of R³ and R⁴ was objected to because it provided for a C-1 alkylene group between these two variables, while they are both bonded to the same nitrogen atom.

The definition of R³ and R⁴ has been amended in the correspondence from applicants dated 9 January 2004 so that this ground for rejection is no longer present in the claim.

The rejection of claims 1-10 under 35 U.S.C. 112, second paragraph, is hereby withdrawn.

Status of Claim Rejections - 35 USC § 103

In the previous Office action, dated 9 October 2003, claims 1-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman et al, "NICOTINE-LIKE STIMULANT ACTIONS OF SEVERAL SUBSTITUTED PHENYLCHOLINE ETHERS" The Journal of Pharmacology and Experimental Therapeutics, vol. 148(1), pages 66-70

Art Unit: 1624

(1965) in view of Organic Chemistry, Paula Yurkanis Bruice, © 1995 Prentice Hall, pages 588-591.

The rejection is hereby withdrawn in view of applicants' arguments in the correspondence dated 9 January 2004, particularly the last full paragraph on page 8 thereof.

The Bruice text teaches a number of weakly electronegative, but strongly inductive aryl substitutions, which, according to Coleman et al, would have also been better substituents than NH₂ on the phenyl ring of the phenylcholine ethers, disclosed in that reference. In view of Bruice, one of ordinary skill in the art might also select hydroxyl, alkoxy, acyl or ester groups from Table 13.1. Therefore, one of ordinary skill in the art would not necessarily have arrived at the claimed invention given the teachings of Coleman et al in view of Bruice.

Allowable Subject Matter

Claims 1-10 are allowed.

The following is an examiner's statement of reasons for allowance:

The claimed compounds, and process for their preparation, are neither obvious over nor disclosed in the prior art.

Applicants' arguments establish that Coleman et al in view of Bruice does not render the claimed compounds obvious. One of ordinary skill in the art would not necessarily have arrived at the claimed invention from a reading of Coleman et al and Bruice.

An updated search did not afford any further applicable prior art disclosure.

Art Unit: 1624

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

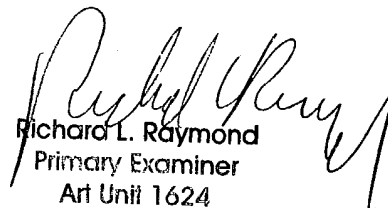
Conclusion

All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-308-5083, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.
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Richard L. Raymond
Primary Examiner
Art Unit 1624